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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,031	05/23/2001	Michael E. Miller	Suros-3-1	1897

10291 7590 11/29/2002  
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EXAMINER	
MARMOR II, CHARLES ALAN	
ART UNIT	PAPER NUMBER
3736	

#16

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/864,031

Applicant(s)

MILLER ET AL.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is responsive to the Response to Election/Restriction Requirement Pursuant to 35 U.S.C. 121 filed October 3, 2002. Claims 1-9 are pending in the Application.

#### ***Election/Restrictions***

2. Applicant's election without traverse of the invention of Group I, claims 1-3, in Paper No. 9 is acknowledged. Claims 4-9 are withdrawn from further consideration.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it fails to identify the parent application of which the benefit is claimed under 35 U.S.C. 120. The instant application is a continuation-in-part of said parent application.

#### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: **65** as illustrated in Figure 3A. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office

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action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Specification*

5. The disclosure is objected to because of the following informalities:
  - a. In paragraph [083], line 12, "113" apparently should read --13--.
  - b. In paragraph [097], line 1, --line-- apparently should be inserted following "pressure".
  - c. In paragraph [102], line 10, "140" apparently should read --40--.
  - d. In paragraph [127], line 3, "motor" (second occurrence) apparently should be deleted.Appropriate correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

*Claim Objections*

7. Claim 1 is objected to because of the following informalities:
  - a. In line 9, --;-- apparently should be inserted following "surface."
  - b. In line 16, "said distal end" apparently should read --a distal end thereof--.Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. ('795) in view of Underwood et al. ('350).

Ryan et al. teach a percutaneous disectomy system including an elongated handpiece 30; a cannula hub (fig. 1) within the handpiece and having a fluid port 62; a tube 60 connected at one end to the fluid port and having an opposite end connectable to a fluid source, the tube disposed within the handpiece; an outer cannula 52 supported at a proximal end by the cannula hub and defining a tissue-receiving opening 56 adjacent a distal end thereof, and a lumen between the proximal and distal ends in fluid communication with the fluid port of the cannula hub; and an inner cutting member 40 slidably disposed within the lumen of the outer cannula and defining a cutting edge 42 at the distal end operable to sever tissue projecting through the tissue-receiving opening. The proximal end of the tube 60 is connected to an irrigation fluid source through irrigation conduit (18 of the controller of Onik et al. ('258) which reference is incorporated in Ryan et al.). Ryan et al. teach all of the limitations of the claim except that the tube is recessed within a channel in the handpiece.

Underwood et al. teach a surgical handpiece design (Fig. 2) where the handpiece 12 includes a longitudinal groove 114 in an outer surface thereof and a fluid delivery tube 110 is recessed within the groove.

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It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to use a surgical handpiece design similar to that of Underwood et al. with a disectomy system similar to that of Ryan et al. as a matter of design choice, merely substituting one known handpiece design for another that provides substantially equal security of the fluid delivery tube relative to the handpiece.

10. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. ('795) in view of Underwood et al. ('350) as applied to claim 1 above, and further in view of Reimels ('347). Ryan et al. as modified by Underwood et al. teach all of the limitations of the claims except that a pinch valve is provided between the fluid source container and the fluid port. Reimels teaches a surgical handpiece (Fig. 8) including a tube **26** for delivering a fluid to a distal end of the fluid port in a hub connected to the handpiece where a pinch valve **58** pinches tube **26** between a fluid container **28** and the fluid port to control the flow of fluid. It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide a tissue cutting device similar to that of Ryan et al. as modified by Underwood et al. with a pinch valve on the tube in view of the teachings of Reimels in order to control the flow of fluid through the tube.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Peters et al. ('957) and Sussman et al. ('785) teach a surgical handpiece including a fluid supply tube on an outer surface thereof. Walker et al. (838) teach a surgical handpiece


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having a channel in an outer surface thereof and a light transmitting cable recessed within the channel.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Charles A. Marmor, II  
Examiner  
Art Unit 3736

CAM  
November 25, 2002